

REMARKS

In response to the above-identified Final Office Action ("Action"), Applicant traverses the Examiner's rejections and seeks reconsideration thereof. In this response, no claims have been amended, no claims have been cancelled and no claims have been added. Accordingly, claims 1-18 are pending.

I. Finality Premature

Applicant respectfully requests withdrawal of the finality of the Action on the basis that it is premature. In particular, in the instant Action, the Examiner introduces new grounds for rejection under 35 U.S.C. §112, first paragraph and based upon U.S. Patent No. 4,610,925 issued to Bonds ("Bonds").

It is improper for a second Office Action including new grounds for rejection to be made final where the "new ground of rejection is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement." See MPEP §706.07(a). Furthermore, in accordance with the principles of compact prosecution, if an enablement rejection is appropriate, it should be presented in the first Office Action on the merits. See MPEP §2164.05. Expanding arguments in a second Office Action may prevent the Office Action from being made final. See MPEP §2164.04.

Applicant did not amend the claims in response to the first Office Action nor did Applicant include Bonds in an information disclosure statement. Moreover, the instant second Action is the first time the Examiner raises the rejection of claims 3, 10 and 18 under 35 U.S.C. §112, first paragraph for failing to comply with the enablement requirement. Thus, since the "new ground of rejection is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement" the finality of the Action is improper. In view of the foregoing, Applicant respectfully requests reconsideration and withdrawal of the finality of the Action.

II. Claim Rejections Under 35 U.S.C. §112

In the outstanding Action, claims 3, 10 and 18 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. In particular, the Examiner states that claims 3, 10 and 18 recite the guide pins being coated with ions, however, there is no

description in the disclosure how the ions are formed with the guide pins and therefore one of ordinary skill in the art would not understand how the ion coated guide pins are made. Applicant respectfully traverses the rejection for at least the following reasons.

To establish a *prima facie* case of lack of enablement the Examiner must provide specific technical reasons in support of the rejection and should specifically identify what information is missing and why one of ordinary skill in the art could not supply the information without undue experimentation. See MPEP § 2164.04. Applicant respectfully submits the Examiner's statements that there is no disclosure as to how the ions are formed with the guide pins and that one of ordinary skill in the art would not understand how the ion coated guide pins are made does not meet this burden. In particular, the Examiner has not indicated any reason as to why one of ordinary skill in the art would not understand how to coat the guide pins with ions without undue experimentation.

The Examiner's rejection must further fail for at least the reason that the application does disclose the information the Examiner indicates is missing, i.e. "how the ions are formed with the guide pins." As recited in the claims and specification, the synthetic material of the guide pins is coated with the ions. See Application, page 5, paragraph [0017]. Specifically, the application recites the following:

"In various embodiments, guide pin 22 may be capable of inactivating and/or removing free radicals from the hair during styling. For example, guide pin 22 may be coated with ions (e.g., negative ions) such that, during use, guide pin 22 is capable of inactivating or removing free radicals from the hair being styled."

Applicant respectfully submits in view of the level of one of ordinary skill in the art, namely that one of ordinary skill in the art understands what an ion is as well as the concept of coating, the above description would sufficiently enable one skilled in the art to make and use the invention recited in claims 3, 10 and 18 without undue experimentation. Thus, for at least the foregoing reasons, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 3, 10 and 18 under 35 U.S.C. §112, first paragraph.

III. Claim Rejections Under 35 U.S.C. §103(a)

A. In the outstanding Final Action Claims 1-2, 4, 8-9, 11 and 15-17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,865,188 issued to Marquez ("Marquez") in view of U.S. Patent No. 3,949,765 issued to Vallis ("Vallis"). Applicant respectfully traverses this rejection for at least the following reasons.

To establish a *prima facie* case of obviousness, the Examiner must show the cited references, combined, teach or suggest each of the elements of a claim. Applicant respectfully submits, neither Marquez nor Vallis teach or suggest "a guide pin" extending farther from the first head and the second head than the plurality of bristles as recited in Claims 1, 8 and 15. In addition, the references fail to teach or suggest both "a first plurality of bristle groups" and "a second plurality of bristle groups" extending from the first head and the second head respectively as recited in Claim 8.

In the outstanding Action, the Examiner alleges Marquez discloses a brush for straightening hair having a first plurality of bristle groups (bristles 16 of head 10 form a group) and second plurality of bristle groups 24 however admits Marquez fails to teach or suggest a guide pin and instead relies upon Vallis to teach this element. See Action, page 3. In particular, the Examiner alleges Vallis discloses a brush for drying hair having a guide pin (8 or 19 Fig. 5), a plurality of bristle groups (col. 2, lines 29-30), the guide pin extending farther from the bristle head than the bristle groups (Figs. 1-3, 5) and the guide pin functions to part the hair as the brush moves. See Action, page 3. The Examiner alleges it would have been obvious to one of ordinary skill in the art to employ guide pins as taught by Vallis into the brush of Marquez for the purpose of parting hair and that parting the hair solves the same problem as the invention which acts as a guiding tool. See Action, page 3. Applicant respectfully disagrees with the Examiner's conclusion for at least the reasons that the Examiner mischaracterizes the teachings of Marquez and Vallis and fails to provide the requisite motivation for the combination.

Applicant respectfully submits, bristle 8 and 19 of Vallis may not be relied upon to teach or suggest a "guide pin" disposed within the plurality of bristles as required by Claims 1 and 15 and a first and second plurality of bristle groups as required by claim 8. As evidenced by Applicant's specification, a guide pin serves to guide surrounding bristles. See Application, page 4, paragraph [0015]. Vallis does not characterize bristles 8 and 19 as guide pins or suggest they provide any sort of a guiding function to surrounding bristles. Instead, Vallis teaches bristles 8 and 19 part the hair to facilitate the flow of air from the attached hairdryer and serve to tone the

scalp by stimulating blood circulation. See Vallis, col. 2, lines 42-59. Nowhere within Vallis is it taught or suggested that bristles 8 and 19 in any way guide adjacent bristles. Applicant respectfully disagrees with the Examiner's indication that bristles 8 and 19 solve the same problem as the claimed guide pin 22 (i.e. guiding adjacent bristles 18). A bristle which facilitates air flow and tones the scalp does not necessarily guide adjacent bristles. Moreover, Vallis teaches that bristles 7 brush the hair and bristles 8 and 19 massage the scalp as the brush is moved through the hair. See Vallis, col. 2, lines 39-41. Thus, it appears from the teachings of Vallis that bristles 8 and adjacent bristles 7 serve different purposes, neither of which result in bristles 8 guiding adjacent bristles 7. Thus, the described functions of bristles 8 and 19 fail to suggest bristles 8 and 19 are Applicant's claimed "guide pins."

In addition, bristles 16, 21 on first brush head 10 of Marquez may not be relied upon to teach a first plurality of bristle groups as required by Claim 8. Marquez expressly states that bristles 16 (e.g. 19, 21) are individual bristles "provided in a grid arrangement with about 25 to 36 individual bristles per square inch." See Marquez, col. 2, lines 49-52. Individual bristles may not be characterized as a plurality of bristle groups. Nevertheless, the Examiner alleges "bristles 16 of head 10 form a group" (emphasis added) and therefore Marquez teaches a first plurality of bristle groups. See Action, page 3. Applicant respectfully submits, combining all the bristles 16 of head 10 to form a single group of bristles does not teach multiple bristle groups as is required by the language "a first plurality of bristle groups" recited in claim 8. For at least the foregoing reasons, the bristles of first brush head 10 may not be characterized as plurality of bristle groups as required by claim 8. Thus, the Examiner inappropriately relies upon Marquez to teach both a "first brush head having a first plurality of bristle groups" and a second brush head having a "second plurality of bristle groups" as required by Claim 8.

Even if it were possible to find the references teach each of the above recited elements, and Applicant does not believe it is, there is no motivation to incorporate the alleged guide pins of Vallis into Marquez in view of the teachings of the references as well as the Examiner's characterization of the bristles groups of Marquez. Marquez teaches a first brush head 10 with individual bristles 16 having a rigid shaft 19 and bulb 20 and a second brush head 12 having a plurality of bristles tufts 27. See Marquez, col. 2, lines 39-67. Marquez teaches the hair may be straightened by squeezing a portion of wet hair between the heads near the scalp and slowly

pulling away from the scalp while the hair is blow dried. See Marquez, col. 1, lines 50-55. Marquez teaches the bristle combination provides for excellent gripping of the hair while still allowing the brush to easily move through the hair. See Marquez, col. 2, lines 4-9. It can be seen from Figure 2, that due to the bristle combination large spaces remain between bristles 16 and 24 when the hairbrush faces are squeezed together. One of ordinary skill in the art would recognize this arrangement as being an essential feature that allows for ease of movement of the hairbrush through the hair. The addition of more bristles to the hairbrush of Marquez as suggested by the Examiner would eliminate the space provided between the bristles likely resulting in increased pulling and tangling of the hair when the hairbrush is pulled to the hair ends. One of ordinary skill in the art would certainly not understand a modification which impedes hairbrush performance in this manner to be desirable.

Moreover, in regard to claim 8, the Examiner characterizes the combination of bristles 16 of head 10 of Marquez as Applicant's claimed "first plurality of bristle groups." As further recited in claim 8, there is "a guide pin disposed within each of the first plurality of bristle groups." Thus, according to the Examiner's characterization of the references, for the combination of Marquez and Vallis to teach "a guide pin disposed within each of the first plurality of bristle groups" as recited in claim 8, bristle 8 or 19 of Vallis would be placed on head 10 of Marquez somewhere amongst the group of individual bristles 16. As can be seen from Figure 3 of Marquez, there are well over 200 rigid bristles 16 spread out over the surface of head 10. One of ordinary skill in the art would not understand placing bristle 8 or 19 of Vallis within a group of over 200 already rigid bristles 16 as taught in Marquez to serve any meaningful purpose.

Thus, for at least the foregoing reasons, neither Marquez nor Vallis alone or in combination may be relied upon to teach or suggest all the elements of Claims 1, 8 and 15. Since the references fail to teach or suggest all the elements of Claims 1, 8 and 15, a *prima facie* case of obviousness may not be established. Applicant respectfully requests reconsideration and withdrawal of the rejection of Claims 1, 8 and 15 under 35 U.S.C. §103 as obvious over Marquez in view of Vallis.

In regard to dependent Claims 2 and 4, these claims depend from Claim 1 and incorporate the limitations thereof. Dependent Claims 9 and 11 depend from Claim 8 and incorporate the limitations thereof. Dependent Claims 16-17 depend from Claim 15 and incorporate the limitations thereof. Thus for at least the reasons discussed above with respect to Claims 1, 8 and 15, Marquez and Vallis further fail to teach or suggest all the elements of Claims 2, 4, 9, 11 and 16-17. Since the references fail to teach or suggest all the element of Claims 2, 4, 9, 11 and 16-17, a *prima facie* case of obviousness may not be established. Applicant respectfully requests reconsideration and withdrawal of the rejection of Claims 2, 4, 9, 11 and 16-17 under 35 U.S.C. §103(a) as being obvious over Marquez in view of Vallis.

B. In the outstanding Action Claims 2, 7, 10, 14 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Marquez in view of Vallis and further in view of U.S. Patent No. 4,601,925 issued to Bond ("Bond"). Applicant respectfully traverses this rejection for at least the following reasons.

Applicant respectfully submits, for at least the reasons previously discussed, Marquez and Vallis fail to teach or suggest the element of a "guide pin" disposed within a plurality of bristles as required by Claims 2, 7, 10, 14 and 18. In addition, the references fail to teach or suggest both a first brush head having "a first plurality of bristle groups" and a second brush head having "a second plurality of bristle groups" as required by Claims 10 and 14. The Examiner has not pointed to, and Applicant is unable to discern, a portion of Bond teaching these elements. Thus, for at least the foregoing reasons, Claims 2, 7, 10, 14 and 18 are not *prima facie* obviousness over Marquez in view of Vallis and further in view of Bond.

Moreover, in regard to Claims 7 and 14, the Examiner states in view of Bond's teaching of bristles having a flexible polyester core it would have been obvious to incorporate boar bristles into the hairbrush of Marquez and Vallis. See Action, page 4. In particular, the Examiner states it would have been obvious to use boar bristles because it has been held that the selection of materials on the basis of its suitability for the intended use is a matter of obvious design choice. See Action, page 4. Neither Marquez nor Vallis contemplate the use of boar bristles. Instead, the references teach the use of synthetic bristle materials for use on wet hair, such as nylons or plastics. One of ordinary skill in the art would understand that boar bristles are

generally softer than synthetic bristles and thus, in the absence of a guide pin such as that disclosed in the instant application, would not understand any advantage to incorporating softer bristles into the brush taught by Marquez for combing through wet hair. Accordingly, upon reviewing Marquez, Vallis and Bond, one of ordinary skill in the art would not understand the incorporation of boar bristles and to be a desirable modification to Marquez in view of Vallis.

Thus, for at least the foregoing reasons, neither Marquez, Vallis nor Bond alone or in combination may be relied upon to teach or suggest all the elements of Claims 2, 7, 10, 14 and 18. Since the references fail to teach or suggest all the elements of Claims 2, 7, 10, 14 and 18, a *prima facie* case of obviousness may not be established. Applicant respectfully requests reconsideration and withdrawal of the rejection of Claims 2, 7, 10, 14 and 18 under 35 U.S.C. §103(a) as obvious over Marquez in view of Vallis and further in view of Bond.

C. In the outstanding Action Claims 5-6 and 12-13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Marquez in view of Vallis and further in view of U.S. Patent No. 4,217,915 issued to Gress et. al. ("Gress"). Applicant respectfully traverses this rejection for at least the following reasons.

Claims 5-6 depend from Claim 1 and Claims 12-13 depend from Claim 8 and incorporate the limitations thereof. For at least the reasons previously discussed, neither Marquez nor Vallis teach or suggest the element of "a guide pin" disposed within a plurality of bristles as found in Claims 5-6 and 12-13. In addition, the references fail to teach or suggest both a first brush head having "a first plurality of bristle groups" and a second brush head having "a second plurality of bristle groups" as required by Claims 12-13. The Examiner has not pointed to, and Applicant is unable to discern, a portion of Gress teaching these elements. Thus, for at least the foregoing reasons, Claims 5-6 and 12-13 are not *prima facie* obviousness over Marquez in view of Vallis and further in view of Gress.

Moreover, in regard to Claims 6 and 13, Gress may not be relied upon to teach a brush head having "a rounded portion opposite the plurality of bristles." The Examiner alleges it would have been obvious to incorporate a ceramic material and rounded portion 8 taught by Gress into the hairbrush of Marquez in view of Vallis for the purpose of distributing heat to the

hair device. See Action, page 5. Applicant respectfully submits, at least for the reason that the rationale provided by the Examiner for combining the references does not rise to the requisite "convincing line of reasoning" as to why it would have been obvious to incorporate the rounded portion of Gress into Marquez in view of Vallis (See MPEP §2142), the rejection must fail.

Additionally, Gress teaches element 8 is a circular hollow cylinder and as shown in Figure 2 referenced by the Examiner, the bristles extend around the entire cylinder. See Gress, col. 2, line 26. Neither reference contemplates rounding of the brush head in the manner taught by Gress. Instead, Marquez teaches a dual head brush having flat heads to facilitate straightening of the hair. One of ordinary skill in the art would recognize that when the hair is placed between the flat faces of the heads for drying, a larger area of the hair may be dried flat than if one of the heads were cylindrical as shown in Figure 2 of Gress. Moreover, the addition of a cylindrical head would cause the hair to curl around the brush, an effect contrary to the stated purpose (i.e. straightening hair) of Marquez. In addition, the brush head taught in Vallis must have a flat surface opposite the bristles to allow the brush to be secured to a hair dryer. Thus modifying Vallis to incorporate a cylindrical head 8 as taught by Gress would render the invention inoperable for its intended purpose. Thus, there is no motivation to combine Marquez and Vallis in the manner suggested by the Examiner.

For at least the foregoing reasons, neither Marquez, Vallis nor Gress alone or in combination may be relied upon to teach or suggest all the elements of Claims 5-6 and 12-13. Since the references fail to teach or suggest all the elements of Claims 5-6 and 12-13, a *prima facie* case of obviousness may not be established. Applicant respectfully requests reconsideration and withdrawal of the rejection of Claims 5-6 and 12-13 under 35 U.S.C. §103(a) as obvious over Marquez in view of Vallis and further in view of Gress.

CONCLUSION

In view of the foregoing, it is believed that all claims now pending patentably define the subject invention over the prior art of record and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes that a telephone conference would be useful in moving the application forward to allowance, the Examiner is encouraged to contact the undersigned at (310) 207 3800.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Date: May 5, 2006



Thomas M. Coester, Reg. No. 39,637

12400 Wilshire Boulevard
Seventh Floor
Los Angeles, California 90025
(310) 207-3800

CERTIFICATE OF FACSIMILE

I hereby certify that this correspondence is being transmitted via facsimile No. (571)273-8300 to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on May 5, 2006.


Jean Svoboda